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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,536	01/04/2002	Dietrich W. Schultz	109476-077UTL	9380
27189 7590 11/16/2007 PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			EXAMINER VAUGHN, GREGORY J	
			ART UNIT 2178	PAPER NUMBER
			NOTIFICATION DATE 11/16/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/039,536	Applicant(s) SCHULTZ ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35 and 37-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35 and 37-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the amendment filed on 8/31/2007.
2. Applicant has amended claims 35, 42, 47 and 48, and added new claims 49-51. Claims 1-34 and 36 were previously canceled.
3. Claims 35, and 37-51 are pending in the case, claims 35, 42, 47, and 48 are independent claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."
5. Claims 49 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. **Regarding dependent claim 49**, the amendment filed 8/31/2007 adds the following limitation: "*a first human readable reference ... and a second human readable reference*". The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
7. **Regarding dependent claim 51**, the amendment filed 8/31/2007 adds the following limitation: "*a specific spatial location within the list document*". The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."
9. Claims 35 and 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautestad US Patent 7,039,860, filed 10/1/1999, patented 5/2/2006 in View of Mani et al., US Patent 6,654,734, filed 8/30/2000, patented 11/25/2003.

10. **Regarding independent claim 35**, Gautestad discloses providing a list document that includes a specification of a feature of a linked document, including information regarding how a plurality of links should be presented, searching a group of linked documents that match the specification, generating a link for the matched document, and adding the link to the list, document. Gautestad recites: "*Queries to the database are processed by script programs which execute a search engine's algorithms to retrieve all the relevant data records from the database that satisfy a specific query from a user. The search engine then returns an HTML-formatted screen image of a list of "hits" to the user who has submitted the query*" (column 2, lines 18-25). See also Figure 3, where a specification is shown at reference sign 200 (shown as "Query A"); and Figure 4A where a link is shown at reference sign 220.

Gautestad discloses automatically updating the list of links when a linked document is added or changed. Gautestad recites: "*This invention relates generally to a method, system, and computer program product for production, revision, and hierarchical organization of electronic documents for local or global electronic network publication in the form of web browser- or word processor-accessible documents containing automatically updated lists with summary information of and hyperlinks to an underlying set of electronic documents with detailed information for each item in a given list*" (column 1, lines 8-15).

Gautestad discloses formatting the links in the list document for presentation on a user interface in accordance with the information regarding how the plurality of

links should be presented. Gautestad recites: "*HTML-formatted screen image of a list of "hits" to the user who has submitted the query*" (column 2, lines 23-25).

Gautestad discloses providing a list document that includes a specification of a feature of a linked document, searching a group of linked documents that match the specification, generating a link for the matched document, adding the link to the list, and updating the links of the list document, as described above. Gautestad fails to disclose the list document including links to both a different document and the same document. Mani is directed to a system for indexing documents. Mani discloses generating a result that includes links to both the same document and a different document. Mani recites: "*An important feature of the query system 10 of this invention is the manner in which data is viewed. An XML document is viewed by the query system as a graph with the "edges" between the graphs used to represent inter-document links. This data model allows queries on content, structure, plus inter-document links and intra-document links*" (column 9, lines 46-50).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine the indexing inventions of Gautestad and Mani in order to optimize the query process by "*indexing both the structure and content of the XML document to minimize the number of steps in the query process*" (Mani, column 2, lines 28-29).

11. **Regarding dependent claim 37**, Gautestad disclose the identifying information as a document name in Figure 5A, at reference sign 256 (shown as the file name "c:\picture1.jpg").

12. **Regarding dependent claim 38**, Gautestad discloses generating a link in Figure 4A, at reference sign 220. A link is a pointer to the location of the file and inherently is based on a file system location.
13. **Regarding dependent claim 39**, Gautestad discloses tracking files that are added, deleted or relocated. Gautestad recites: *"This invention relates generally to a method, system, and computer program product for production, revision, and hierarchical organization of electronic documents for local or global electronic network publication in the form of web browser- or word processor-accessible documents containing automatically updated lists with summary information of and hyperlinks to an underlying set of electronic documents with detailed information for each item in a given list"* (column 1, lines 8-15).
14. **Regarding dependent claim 40**, Gautestad discloses updating the list document when the list document is published. Gautestad recites: *"A method, system and computer program product for revising and publishing electronic documents"* (abstract).
15. **Regarding dependent claim 41**, Gautestad discloses updating the list document when a content file is created or changed. Gautestad recites: *"This invention relates generally to a method, system, and computer program product for production, revision, and hierarchical organization of electronic documents for local or global electronic network publication in the form of web browser- or word processor-accessible documents containing automatically updated lists with*

summary information of and hyperlinks to an underlying set of electronic documents with detailed information for each item in a given list" (column 1, lines 8-15).

16. **Regarding claims 42, 47 and 48**, the claims are directed toward a system and a method, respectively, for the method of claim 35, and are rejected with the same rationale.
17. **Regarding dependent claim 43**, Gautestad discloses using a location in a file structure as an identifying feature of the linked document. Gautestad recites: "*An ini-file is a text file containing various parameters for the system setup such as, for example, field captions, location of various file types, etc. In NetSpinner, one can allow for other program settings that can be easily modified if the settings were read from various text files, such as ini-files. Such files instructing NetSpinner to update the local website copy only de-activates the "Update Internet" FTP or HTTP function*" (column 15, lines 55-62).
18. **Regarding claim 44**, the claims is directed toward a system for the method of claim 37, and is rejected with the same rationale.
19. **Regarding claims 45 and 46**, the claims are directed toward a system for the method of claims 40 and 41, respectively, and are rejected with the same rationale.
20. **Regarding dependent claim 49**, Gautestad discloses the presented links as human readable links. Gautestad describes the links as: "*The search engine then returns an HTML-formatted screen image of a list of "hits" to the user who has*

submitted the query" (column 2, lines 23-25). Presenting a list of hits to a user indicates that the list is human readable. As described above, Mani discloses the links as references to locations that are external to the list document, and locations that are internal to the list document. Mani recites: "*An important feature of the query system 10 of this invention is the manner in which data is viewed. An XML document is viewed by the query system as a graph with the "edges" between the graphs used to represent inter-document links. This data model allows queries on content, structure, plus inter-document links and intra-document links*" (column 9, lines 46-50).

21. **Regarding dependent claim 50**, Gautestad and Mani disclose a URL that is different from a URL for the list document. As described above, Mani discloses an "*inter-document link*" which is a URL for a document that is different than the list document, and hence would be URL that is different from a URL for the list document.
22. **Regarding dependent claim 51**, Gautestad and Mani disclose a URL that is internal to the list document and to a specific location within the list document. As described above, Mani discloses an "*intra-document link*" which is a URL for a specific location within the list document.

Response to Arguments

23. Applicant's arguments filed 8/31/2007 have been fully considered but they are not persuasive.
24. Applicant argues that there is no motivation to combine the cited prior art references (page 7, last paragraph to page 9, third paragraph, of the response filed 8/31/2007). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mani provides motivation, in that it would have been obvious, to one of ordinary skill, at the time the invention was made to combine the indexing inventions of Gautestad and Mani in order to optimize the query process by "*indexing both the structure and content of the XML document to minimize the number of steps in the query process*" (Mani, column 2, lines 28-29).
25. Applicant also argues that the combination of references would not provide a reasonable expectation of success (page 9, fourth paragraph to page 10, second

paragraph, of the response filed 8/31/2007). Gautestad teaches a query results list that includes links to relevant items related to the query. Mani teaches that the result lists can include intra-document links (internal) and inter-document links (external). Gautestad's result list is in human readable form.

26. Applicant further argues that the combined references fail to disclose all the claim limitations (page 10, third paragraph to page 11, first paragraph, of the response filed 8/31/2007). Specifically applicant argues that the combined references fail to disclose the link presentation information and formatting based upon the presentation information as recited in the newly amended claims. As described above Gautestad discloses this feature. Gautestad recites: "*HTML-formatted screen image of a list of "hits" to the user who has submitted the query*" (column 2, lines 18-25).

27. Applicant also argues that the combined references fail to disclose "*automatically updating the list document when the links change*" (page 10, third paragraph, of the response filed 8/31/2007). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*automatically updating the list document when the links change*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claimed limitation applicant is referring to is directed toward "updating the links

of the list document when the linked document is added or changed" (emphasis added). As described above, Gautestad discloses this updating feature. Gautestad recites: "*documents containing automatically updated lists with summary information of and hyperlinks to an underlying set of electronic documents*" (column 1, lines 8-15).

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

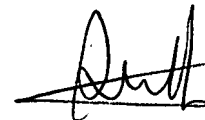
29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
Patent Examiner
November 2, 2007



STEPHEN HONG
SUPERVISORY PATENT EXAMINER